

REMARKS/ARGUMENTS

Status of Claims

Claims 2-6, 8-13, 15-17, 19-22, 24-29, 31, 33-34, 36, 39-40, 45-49, and 52-56 are currently pending in this application. Claim 56 has been amended. Claims 1, 7, 14, 18, 23, 30, 32, 35, 37-38, 41-44, and 50-51 have been canceled.

Claim Objections

Applicants respectfully submit that claim 21 (reciting "the transfer cylinder") depends from claim 45 (reciting "a transfer cylinder"), and thus antecedent basis for "the transfer cylinder" in claim 21 is correct.

Allowable Subject Matter

Applicants note with appreciation that claims 2-4, 8, 15, 19, 24, and 36 are allowed.

35 USC § 103 Claim Rejections

Claims 5, 6, 9, 10, 13, 16, 17, 20-22, 25-29, 31, 33, 34, 39, 40, 45-49, and 52-56 stand rejected under 35 USC § 103(a) as being unpatentable over *DeMoore* (5,979,322) in view of *Koelsch* (5,410,964). Applicants respectfully traverse the rejection and submit that the combination of *DeMoore* and *Koelsch* (if proper) does not establish a *prima facie* case of obviousness as to the pending claims. According to MPEP § 2142, three basic criteria must be met to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Applicants respectfully submit that the Examiner's reading of *DeMoore* and *Koelsch*, alone and in combination, is incorrect. Furthermore, Applicants respectfully submit that the combination of *DeMoore* and *Koelsch* (if proper) does not produce a reasonable expectation of success, and is in fact inoperable. Therefore, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness as to the pending claims.

A. The Examiner's reading of *DeMoore* is incorrect

The Examiner states that *DeMoore* teaches an integrated anti-marking cover for a transfer cylinder in a rotary printing press. Applicants respectfully traverse that *DeMoore* teaches such an integrated anti-marking cover as disclosed and claimed by Applicants. Specifically, Applicants bring to the Examiner's attention the following passage from col. 10, lines 28-59 of *DeMoore*:

Referring again to FIG. 3, the preferred method of attaching the flexible jacket covering 68 to the delivery transfer cylinder 10D is illustrated. First, the low friction, conductive cylinder base covering 62 is secured around the bare cylinder surface 38 of the transfer cylinder rim 34 by the clamp bars 64, 66 as shown in FIG. 1. Next, the prefabricated, flexible jacket covering 68 is positioned over the cylinder base covering 62 with its centering marks 104, 106 in registration with the corresponding centering marks 54, 56, on the low friction, conductive cylinder base covering 62. Also, the edge alignment stripes 92, 98 of the flexible jacket covering are positioned on the operator and gear side edges of the transfer cylinder.

After the initial placement of the flexible jacket covering 68, registration of the respective centering marks and alignment of the alignment stripes are verified. The gripper reinforcement strip 70G is positioned flush against the gripper edge clamp bar 64 which sets the horizontal alignment stripes 80, 82, 84 in parallel alignment with the gripper and tail edges 34G, 34T of the transfer cylinder rim 34. The exposed adhesive side 70A of the gripper edge reinforcement strip 70G is then pressed onto the gripper edge portion 62G of the cylinder base covering 62 that overlies the gripper flange 37. Next, the tail reinforcement strip 70T is positioned flush against the tail edge clamp bar 66 which sets the horizontal stripes 86, 88, 90 in parallel alignment with the gripper and tail edges 34G, 34T of the transfer cylinder rim 34. The exposed adhesive side 70A of the tail edge reinforcement strip 70T is then pressed onto the tail edge portion 62T of the cylinder base covering 62 that overlies the tail flange 39.

In contrast to an integrated anti-marking cover, this text clearly demonstrates that *DeMoore* discloses two separate and distinct components: a cylinder base cover 62 and a flexible jacket covering 68 which are installed sequentially on the transfer cylinder. *DeMoore* is representative of the state of the art prior to Applicants' present invention in that the cylinder base cover and the flexible jacket covering are distinct components that require time consuming sequential installation. As disclosed in the text above, the first step in installation is to secure the cylinder base cover 62 to the bare cylinder surface 38. Next, the flexible jacket covering 68 positioned over the cylinder base covering 62 and properly registered and aligned. Lastly, the flexible jacket covering 68 is adhered to the cylinder base cover 62 via "peel-and-stick" with the exposed adhesive side 70A.

In contrast, Applicants disclose and claim an integrated anti-marking cover. The term "integrated" is defined in Webster's Collegiate Dictionary, 10th Edition, as "to form, coordinate, or blend into a functioning or unified whole: unite" or "to incorporate into a larger unit." From the description set forth above, it should be readily clear that the separate components of *DeMoore* are not the same as or equivalent to the integrated anti-marking cover disclosed and claimed by Applicants. Thus, the Examiner's statement that "DeMoore teaches an integrated anti-marking cover for a transfer cylinder in a rotary printing press" is incorrect.

B. The Examiner's reading of *Koelsch* is incorrect

The Examiner relies upon *Koelsch* as teaching a flexible jacket covering stitched to a carrier sheet (36) on a cylinder. Applicants respectfully submit that this is an incorrect reading of the reference. On a big picture level, *Koelsch* does not even relate to the same type of printing apparatus as that described by Applicants. Specifically, Applicants' disclosure is directed to anti-marking covers for transfer cylinders in a rotary offset printing press, where printed substrates are transferred between successive printing units. For example, in a four-color printing press, the printed sheets are transferred between each unit where a different color is applied to the printed substrate. In transferring the sheets between printing units, a need exists for anti-marking covers on the transfer cylinders to avoid undesirable smearing and marking of the printed substrate.

In contrast to rotary offset printing in a multicolor press, *Koelsch* relates to a completely different type of printing, namely flexographic or aniline printing. Flexographic printing is relief, i.e., direct, printing utilizing large plates fastened to a rotating cylinder. Referring to Fig. 3, *Koelsch* relates to the attachment of a carrier sheet 40 to a printing cylinder 28. The carrier sheet 40 includes a printing plate 42 and has a lead edge strip 50 for connection to the printing

cylinder 28. The carrier sheet 40 may be attached to the lead edge strip 50 by stitching or staples 68. The focus of *Koelsch* is in a novel way to attach the carrier sheet 40 to the printing cylinder 28 through use of an improved lead edge strip 50. No where does *Koelsch* teach or suggest use of a flexible jacket covering of the type suitable for use in anti-marking covers for transfer cylinders. Thus, the Examiner's statement that *Koelsch* teaches "a flexible jacket covering stitched to a carrier sheet" is incorrect.

C. The Examiner's reading of the combination of *DeMoore* and *Koelsch* is incorrect

Assuming for the sake of argument that the combination of *DeMoore* and *Koelsch* is correct (without conceding such), the Examiner states that "[i]t would have been obvious to modify *DeMoore* et al. to replace the adhesive connection of *DeMoore* et al. with stitching, since *Koelsch* teaches that stitching is a secure means for attaching together components of a cylinder assembly." As discussed previously, *Koelsch* teaches that stitching may be used to connect a lead edge strip 50 to a carrier sheet 40 for attachment of the carrier sheet to the printing cylinder 28. Assuming for the sake of argument that the carrier sheet 40 of *Koelsch* is equivalent to the cylinder base cover 62 of *DeMoore*, the combination of *Koelsch* and *DeMoore* would teach at most that the cylinder base cover 62 of *DeMoore* could be modified to include a lead edge strip stitched to the cylinder base cover. Notably, *DeMoore* already includes such teaching at col. 11, lines 7-18:

Preferably, the attachment surface areas are modified by covering them with bonding strips 91, 95 preferably constructed of thin strips of polyester film, for example as sold by DuPont under its brand name MYLAR™. The bonding strips are permanently attached onto the gripper and tail attachment surface areas as shown in FIG. 4 and FIG. 4A. Attachment of the polyester film strips 91, 95 is

preferably made by threaded stitchings 93, 97 that penetrate the polyester strips and the cylinder base covering 62. The adhesive sides 70A of the reinforcement strips 70G, 70T form a secure adhesive bond onto the polyester film bonding strips 91, 95.

Therefore, to the extent that *Koelsch* teaches or suggests that the cylinder base cover 62 of *DeMoore* can be modified to include a lead edge strip stitched thereto, *DeMoore* already contains such teaching in the form of the polyester bonding strips 91, 95 stitched to the cylinder base cover 62. In short, the combination of *Koelsch* with *DeMoore* does not provide any additional teaching or suggestion beyond that already described in *DeMoore*. Furthermore, the general statement that “*Koelsch* teaches that stitching is a secure means for attaching together components of a cylinder assembly” is likewise of little instructional value as the Examiner does not specify what components that *Koelsch* suggests stitching together. As just described, *Koelsch* at most teaches stitching a lead edge strip to a cylinder base cover for the purpose of more securely attaching the cover to the underlying cylinder, which *DeMoore* already does. The selection and stitching of the specific component recited by Applicants, namely stitching the flexible jacket covering to the cylinder base covering, is not taught or suggested by a general teaching that “components” may be stitched together and is only evident in view of Applicants’ own teaching – which constitute impermissible hindsight that the Examiner is prohibited from using. According to MPEP § 2142, hindsight reconstruction of the prior art based on the Applicants’ disclosure is impermissible, and the legal conclusion must be reached on the facts gleaned from the prior art. In sum, the combination of *Koelsch* does not add any additional teaching beyond that already contained in *DeMoore*. Furthermore, the general suggestion that “components may be stitched together” is completely inadequate to teach or suggest the specific

structure recited in the pending claims. Thus, the Examiner's reading of what is taught by a combination of *DeMoore* and *Koelsch* is incorrect, and the combination of *DeMoore* and *Koelsch* (if proper) does not make up for the deficiencies of *DeMoore*.

D. The combination of *DeMoore* and *Koelsch* is inoperable

Assuming for the sake of argument that the Examiner's combination of *DeMoore* and *Koelsch* is correct and that the reading of the combined teaching is correct, the Examiner has nonetheless failed to establish a *prima facie* case of obviousness as such combination does not produce a reasonable expectation of success. The Examiner states that "[i]t would have been obvious to modify *DeMoore et al.* to replace the adhesive connection of *DeMoore et al.* with stitching." Assuming that this is correct, the result is an inoperable combination. As described previously, *DeMoore* discloses two separate and distinct components: a cylinder base cover 62 and a flexible jacket covering 68 which are installed sequentially on the transfer cylinder. The first step in installation is to secure the cylinder base cover 62 to the bare cylinder surface 38. Next, the flexible jacket covering 68 positioned over the cylinder base covering 62 and properly registered and aligned. Lastly, according to the Examiner, the flexible jacket covering 68 is stitched rather than adhered to the cylinder base cover 62. The Examiner's proposed modification is completely inoperable as the flexible jacket covering 68 cannot be stitched to the cylinder base covering 62 after the cylinder base covering has been installed on the transfer cylinder. More specifically, a needle or other stitching means could not penetrate the cylinder base cover 62 due to the presence of the transfer cylinder, which is typically made of metal. Thus, it would be physically impossible to combine the references as suggested by the Examiner. Furthermore, one skilled in the art would never be motivated to undertake such a process (even if physically possible), as such a process would be extremely time consuming in comparison to the

use of “peel-and-stick” adhesive as taught by *DeMoore*. As taught by Applicants on page 6 of the specification, the typical operating cost of a four-color offset printing press is about \$300 to \$500 per hour, and thus Applicants provide a means to shorten press down time, not lengthen it. Thus, the Examiner’s proposed amendment would render *DeMoore* inoperable for its intended purpose, which is prohibited by MPEP § 2143.01.

For the reasons set forth above, the prior art relied upon by the Examiner does not teach stitching a flexible jacket covering to a cylinder base cover as recited in claims 5, 6, 9-13, 16, 17, 20-22, 25-29, 31, 33, 34, 39, 40, 45-49, 52-55, which therefore are allowable over the art of record. Claim 56 does not recite stitching. However, in an effort to substantively advance prosecution, claim 56 has been amended to recite that the anti-marking cover forms “a single component is provided for installation on the transfer cylinder” (as described on page 30 of the specification), which further clarifies and distinguishes the integrated anti-marking cover of claim 56 from the separate, two-component system of the prior art. Therefore, claim 56 is allowable over the art of record for the reasons set forth above.

Claim 11 stands rejected under 35 USC § 103(a) as being unpatentable over *DeMoore* in view of *Koelsch* and further in view of *Okuda*. Claim 12 stands rejected under 35 USC § 103(a) as being unpatentable over *DeMoore* in view of *Koelsch* and further in view of *Hannon*. Assuming for the sake of argument that the art combinations are proper (without conceding such), the Examiner has nonetheless failed to establish a *prima facie* case of obviousness as such combinations do not teach or suggest all of the claim limitations. Claims 11 and 12 depend from and incorporate the limitations of independent claim 45. As discussed previously, the combination of *DeMoore* and *Koelsch* does not disclose each and every element of claim 45, namely “stitching.” The secondary references, *Okuda* and *Hannon*, do not make up for the lack

of teaching of the primary references, and therefore claims 11 and 12 are likewise allowable over the prior art of record.

CONCLUSION

Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections and objections is respectfully requested by Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated December 23, 2004 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

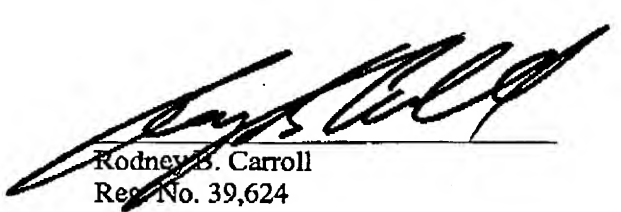
Respectfully submitted,

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3-7-05

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